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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/610,938	06/30/2003	James Harold Gray	ATT030074	2526

84326 7590 07/21/2010  
AT & T LEGAL DEPARTMENT - Toler  
ATTN: PATENT DOCKETING  
ROOM 2A-207  
ONE AT & T WAY  
BEDMINISTER, NJ 07921

EXAMINER
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INGVOLDSTAD, BENNETT

ART UNIT	PAPER NUMBER
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2427

MAIL DATE	DELIVERY MODE
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07/21/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/610,938	<b>Applicant(s)</b> GRAY ET AL.	
	<b>Examiner</b> Bennett Ingvoidstad	<b>Art Unit</b> 2427	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14, 16, 35, 54 and 66-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 16, 35, 54 and 66-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/2010 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 13 May 2010 have been fully considered but they are not persuasive. Applicant argues that the cited references do not teach the new limitations requiring that the hot key icon is displayed "with an EPG" and that the additional content is viewable at any time it is selected by the user. Regarding the first limitation, Ellis teaches that the received messages may be displayed by a messaging application, which is part of a program guide (Abstract). Thus, in combination with Kunkel's teaching that a received message may comprise a hot key icon for display, the limitation is met because the icon is displayed with a messaging system, which is part of an EPG. Regarding the second limitation, Kunkel teaches that a user may select additional content at anytime a hot key icon is displayed (col. 4, ll. 54–59). Therefore the cited references in combination teach the new limitations.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 54 and 74–77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** Claim 54 sets forth a “machine readable medium.” The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a machine readable medium (also called computer readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 14, 16, 35, 54, and 66–77 are rejected under 35 U.S.C. 112,**

**first paragraph, as failing to comply with the written description**

**requirement.** The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Independent claims 14, 35, and 54 each contain subject matter from separate mutually exclusive embodiments. (See the Restriction Requirement dated 14 May 2008, the 112 rejections in the Non-Final Action dated 25 November 2008, and the 112 rejections in the Final Action dated 22 April 2009 for discussions of the exclusivity of the embodiments). Specifically, the claims are primarily drawn to the first elected embodiment (Figs 1A–D), whereby a hot key related to a currently-viewed advertisement is provided to the user. However, the claims are now amended to include a limitation of the second non-elected embodiment (Figs 2A–D), whereby a hot key is displayed “with an electronic programming guide (EPG)” in response to selecting an EPG program with a cursor. No support is provided in the specification for combining the elected embodiment with the non-elected embodiment. Therefore, the claims contain new matter.

Additionally, the claims are amended to require that “additional content is viewable by the user at any time specified by the user.” Applicant points to no support for this limitation. In contrast, the specification teaches that additional content may be selected only for as long as a hot key icon is displayed. See paras. 0029, 0039 of PG-Pub 2004/0268416. Therefore, the additional content is viewable only for the duration that the hot key icon is displayed on screen, rather than “at any time.” Therefore the claims further contain new matter.

Dependent claims 67–69, 71–73, and 75–77 are further drawn to aspects of the second embodiment pertaining to displaying the hot key with an EPG, and thus contain additional new matter.

Dependent claims 70 and 74 further require that the processor/medium of the system causes a hot key user fee to be sent to the provider of a hot key before the hot key is received. The specification briefly mentions that content providers may charge users to receive a hot key service. See paras. 0033, 0041 of PG-Pub 2004/0268416. However, the specification does not further teach that the user fee is provided by the processor or computer medium of the system as claimed. For example, the fee could be provided through a separate billing system, rather than through the set top box. Therefore, the claims contain additional new matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 14, 16, 35, 54, and 66–77 are rejected under 35 U.S.C. 103(a)**  
**as being unpatentable over US 7100183 (“Kunkel”) in view of US**  
**2007/0124763 (“Ellis”).**

Claim 14. Kunkel teaches a method comprising receiving at a user device a hot key signal (col. 3, lls. 36–49: demographic codes) from a television provider network, the hot key signal related to an advertisement being viewed by a user of the user device (col. 2, lls. 4–14: the codes indicate that additional information about an advertisement is available); the hot key signal indicating availability of additional content comprising an additional advertisement (id.); determining, at the user device independent of any request by the user but based in part on whether the additional content is related to the advertisement (see col. 2, lls. 4–14: describing that hot key codes are displayed based on the currently-watched advertisement), whether the hot key is relevant to the user (id.: using bit masks to determine if the user fits a demographic profile for the additional information); responsive to determining the hot key signal is relevant, displaying on a screen a hot key indicating that the hot key signal has been received and the availability of the additional content (see col. 4, lls. 47–53); and responsive to receiving an indication that the hot key is accepted (col. 4, lls. 55–59), displaying on the screen the additional content as video programming (col. 4, l. 65 – col. 5, l. 6:

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displaying a video presentation), wherein the additional content is selectable at any time the hot key is on the screen (col. 4, ll. 54–59).

Kunkel teaches that the demographic codes (hot key messages) may be delivered by a third party, but Kunkel does not further teach that the hot key signal comprises an IP data packet. Nor does Kunkel teach that the hot key signal is displayed with an EPG.

Ellis teaches a targeted message system for providing additional information about products and services (Fig. 13), where the targeted message may be sent via the Internet (claim 2), the message thus comprising an IP packet with a body and header portion, the body portion indicating an additional information location (see information 86, Fig. 7). Ellis further teaches that a messaging system for displaying messages may be part of a program guide (Abstract).

It is obvious to combine known elements according to known methods to yield predictable results. Therefore, it would have been obvious to combine Kunkel's targeted message that may be delivered by a third party with Ellis's teaching of an IP message according to the described method of delivering the message from a third party through the Internet, thus yielding the same predictable results of receiving the targeted message at the user device. Further, it would have been obvious to implement the messaging system for displaying the message as a part of the program guide, as taught by Ellis, thus yielding the predictable result of displaying the hot key icon “with the program guide,” i.e., as part of the program guide.



Claim 16. Ellis further teaches determining whether the hot key signal is relevant to user by determining that a destination address of the signal is an address of the user device (IP packets use destination addresses for delivery).

Claim 35. Kunkel in view of Ellis further teaches a system for implementing the above method, the system comprising a receiving portion and a processor (Kunkel Fig. 1).

Claim 54. Kunkel in view of Ellis further teaches a machine readable medium having instructions stored thereon for implementing the above method on the receiver indicated above (Kunkel Fig. 1).

Claims 66, 70, 74. OFFICIAL NOTICE is taken that it was well known to require a user to pay for an interactive television service. Therefore, it would have been obvious to require the user of the hot key receiving service to pay a fee to the hot key provider prior to receiving the hot key service, for the purpose of defraying the costs of providing the service and/or making a profit from the service.

Claims 67, 71, 75. Ellis further teaches that the icon is displayed “within the EPG,” since the display system for displaying the icon/message is a part of the program guide (Abstract).

Claims 68, 72, 76. Kunkel further teaches that the hot key icon is an indication of the manner in which the user may accept the hot key, since the display of the hot key icon indicates to the user that the user may press a key to accept the additional content (col. 4, ll. 50–59).

Claims 69, 73, 77. Kunkel further teaches that the additional content may be a web page (col. 5, ll. 1–2), which includes information informing a user of alternate related content (e.g., web links).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Ingvaldstad whose telephone number is (571) 270-3431. The examiner can normally be reached on M–F 9–5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Bennett Ingvoldstad/  
Examiner, Art Unit 2427

/Scott Beliveau/  
Supervisory Patent Examiner, Art Unit 2427